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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,291	03/09/2001	Shimon Shmueli	4989-007	1208
27820	7590	10/14/2005		
WITHROW & TERRANOVA, P.L.L.C. P.O. BOX 1287 CARY, NC 27512			EXAMINER VU, KIEU D	
			ART UNIT 2173	PAPER NUMBER

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,291

Applicant(s)

SHMUELI ET AL.

Examiner

Kieu D. Vu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9,11-23,25,27-35,37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-23,25,27-35,37 and 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office action is responsive to the Request for Continued Examination (RCE) filed under 37 CFR §1.53(d) for the instant application on 08/01/05.

Applicants have properly set forth the RCE, which has been entered into the application, and an examination on the merits follows herewith.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 41 is rejected as the original disclosure fails to provide support for the subject matter as now claimed.

Specifically, support for the exclusionary statement "without requiring the host computing device to reboot" in claim 41 which was added into the claim by amendment is not found in the original disclosure of the instant application.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP 2173.05(i). As such, the limitation(s), *supra*, must be deleted from the claims in response to this action.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 25, and 37 recite the limitation "the banner". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5-7, 9, 12-15, 17, 21-23, 25, 28-29, 33-35, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (USP 5,954,808) and Krishan et al (USP 6442529 B1).

Regarding claims 1, 17, and 29, Paul teaches a portable device (configuration card 18) which has a body (see Figure 4B for the body of the configuration card 18), a memory (memory 20) containing software for loading into read/write memory of a host computing device (audiovideo device 10 in Figure 2) and executing on the host computing device (see col. 4, lines 14-40), said software comprising a computer program (computer instruction, col. 4, lines 15-18); an interface to facilitate interaction with the host computing device (communications Interface 22; see col. 3, lines 58-65); and the software adapted to automatically execute on the host computing device in association with a computing session (booting up a processor 24; col. 4, lines 46-50) and provide an interface frame associated with the portable device on a display of the host

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computing device (col 3, lines 58-65). Paul differs from the claim in that Paul does not teaches that the software is further adapted to instruct the host computing device to display predefined content wherein the predefined content is associated with a provider of the portable device. However, such feature is known in the art as taught by Krishan. Krishan teaches a method and apparatus for delivering targeted information and advertising over the Internet (col 1, lines 14-20). Krishan further teaches instructing the host computing device to display predefined content wherein the predefined content is associated with a provider of the portable device (Fig. 3, 7-8) (col 4, lines 38-46; col 6, lines 35-48, col 22, lines 8-25). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Krishan before him at the time the invention was made, to modify the configuration system card taught by Paul to include displaying predefined content wherein the predefined content is associated with a provider of the portable device taught by Krishan with the motivation being to enable Paul's system to display advertisements on user's screen.

Regarding claims 5-6, 21-22, and 33-34, Paul teaches the providing a link to a web site (user's view to web pages) on the interface frame (col 5, lines 59-63).

Regarding claims 7, 23, and 35, Paul teaches the display the web content in the interface frame (user's view to web pages) (col 5, lines 59-63).

Regarding claims 9, 25, and 37, Krishan teaches message window 64 includes markup language content defined by web content (col 20, lines 8-13).

Regarding claims 12, 28, and 40, Paul teaches the pushing web content (web pages) (col 5, lines 59-63).

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Regarding claims 13-14, Paul teaches the emulating and adapting as a file system (col 3, lines 28-35).

Regarding claim 15, Paul teaches the interfacing a port in the host computing device (col 1, lines 40-45).

8. Claims 11, 27, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Krishan, and Hendrick (USP 6792464 B2).

Regarding claims 11, 27, and 39, Paul does not teach providing an authentication routine to execute on the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick's system comprises an authentication routine which verifies user's login identification and password by comparing user's login information with authentication information stored in the memory of the data card (col 4, lines 38-52). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify the configuration card taught by Paul to include PIN verification taught by Hendrick with the motivation being to prevent the fraudulent use of the configuration card.

Regarding claim 41, Paul does not teach the software adapted to automatically execute on the host computing device independent of a boot state of the host computing device. However, such feature is known in the art as taught by Hendrick. Hendrick teaches a system for automatic connection to a network, the system enables software contained in a smart card to automatically execute on the system independent of a boot state of the host computing device (col 6, lines 18-26) ("upon system", "the system moves to the trigger detection

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step..." shows that the host computing device is booted). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Hendrick before him at the time the invention was made, to modify Paul's system to include the feature that the software can automatically execute on the host computing device independent of a boot state of the host computing device taught by Hendrick with the motivation being to enable the software to execute without having to reboot the computer.

9. Claims 2-4, 18-20, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Krishan, and Suga et al ("Suga", USP 5497455).

Regarding claims 2, 18, and 30, Paul does not teach the displaying icon on the interface frame. However, such feature is known in the art as taught by Suga. Suga teaches a portable computer which has a task selection menu which comprises the displaying an icon, which when selected, the software will execute the corresponding function on the host computing device (col 2, lines 26-31). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Suga before him at the time the invention was made, to modify the portable device taught by Paul to include the icon display taught by Suga with the motivation being to help user to easily and quickly access functions (Suga, icon screen for task selection, col 2, lines 3-5).

Regarding claims 3-4, 19-20, and 31-32, Suga teaches the display a menu icons corresponding to a menu of function icons (Fig. 4).

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul, Krishan, and Yee et al ("Yee", USP 5781723).

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Regarding claim 16, Paul does not teach a wireless interface. However, such feature is known in the art as taught by Yee. Yee teaches a system for self-identifying a portable information device which comprises the wireless interface (col 4, lines 1-3). It would have been obvious to one of ordinary skill in the art, having the teaching of Paul and Yee before him at the time the invention was made, to modify the portable device taught by Paul to include the wireless interface taught by Yee with the motivation being to enhance the portability of the system by enabling wireless communication between devices (Yee, wireless communication link, col 4, lines 32-37).

11. Applicant's arguments filed 08/01/05 have been considered but they are now moot under new ground of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

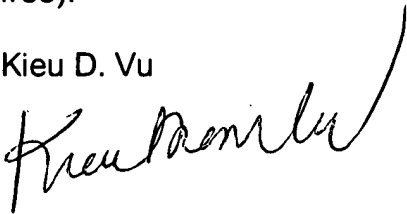
571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kieu D. Vu

A handwritten signature in black ink, appearing to read 'Kieu D. Vu', with a long, sweeping flourish extending from the end of the name.